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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/699,262      | 10/27/2000  | Kai Cieliebak        | CH919990038US1      | 7389             |

7590

08/16/2006

IBM CORPORATION  
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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3693

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/699,262

Applicant(s)

CIELIEBAK ET AL.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 3/28/06.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/28/06 has been entered.

3. Claim 1 has been amended per request.

#### ***Response to Arguments***

3. Applicant's remarks with respect to claims 1-4 have been considered. However, the amended claim 1 contains many deficiencies, which render the claimed invention non-statutory under 35 USC 101. The claim is recite limitations which renders the claim as a whole indefinite and therefore rejectable under 35 USC 112 (second). Detailed explanation is provided below.

#### ***Claim Rejections - 35 USC § 112***

4. Claims 1-4 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4.1 Method claim 1 recites several process steps without specifying inter-relation among the processes involved. The claimed invention must be recited in such a manner that all limitations are forms relationship to each other. It is not necessary that each process step be functionally linked to other process steps of the claims. However, “disjoint” process steps raises issued of indefiniteness as explained below.

4.2 Step c. recites “evaluating performance” without providing any context of the evaluation as relating to the claimed subject matter and specifically defining the terms “performance” and “evaluating”. These deficiencies render the claim indefinite.

Step c. further, recites “the second value of the actual level of risk and return for the current portfolio and the efficient portfolios” whereas step b. refers to the second value as “a second value of an actual level of risk and return for the service provider..”. This recitation is in error because the second value only pertains to the *actual* of level of risk and return and has no connection to the desired level of risk and return.

4.3 Step d. recites, “implementing corrective action” which is vague and indefinite because the term “corrective action” is not defined with a reasonable degree of particularity and distinctness. The examiner interprets that the corrective action is implemented without a computer, i.e. it involves human judgment (as is further evident from the possible actions enumerated in dependent claim 2). The corrective action is based upon a manual decision making (i.e. human judgment) and therefore, cannot be ascertained with any degree of

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definiteness and therefore the step of implementing a corrective action is disembodied “abstract idea.”.

4.4 Based upon the foregoing analysis, it is concluded that claim 1 and dependent claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

### **Claim Rejections - 35 USC § 101**

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.1 Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (refer to web link, [http://www.uspto.gov/web/offices/pac/compexam/interim\\_guide\\_subj\\_matter\\_eligibility.html](http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html) for details), a claimed invention as a whole must be useful and accomplish a practical application.

5.2 To determine whether the claimed invention satisfies the “practical application” requirement, the claimed invention must produce a useful, concrete and tangible result. The focus is on the result of the claim as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claim or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable exception or it is merely likely that it would occur, it does not “flow inherently therefrom” and the claim would need to be amended to specifically recite the result.

5.3 Claim 1, does not produce a useful, concrete and tangible result because, step d. merely states that a corrective action is implemented with the intended result that actual risk and return are adjusted for the service provider. There is no positive recitation in the claim that the

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adjustment of “actual risk and return” occur as intended. Even if such a step is positively recited in the claim, the corrective action is treated as a subjective action based upon human judgment, since a broad interpretation the term “corrective action” is that it is indefinite and therefore lacks “concreteness”. See 112 (second) rejection above. Furthermore, applying the same reasoning it is asserted that the claim(s) also do not produce a tangible result. Accordingly, it is concluded that Claims 1-4, are not limited to a practical application and therefore are rejected 35 USC 101.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

8/14/06